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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/580,305
Filing Date: May 26, 2000
Appellant(s): SHAH-NAZAROFF ET AL.

Robert McDowell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/16/2009 appealing from the Office action mailed 1/22/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct

(4) Status of Amendments

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Majeti et al. (U.S. Patent No. 5,512,935) issued April 30, 1996

Rothblatt (U.S. Patent No. 6,105,060) issued August 15, 2000

Beyers, II et al. (U.S. Patent No. 5,155,590) issued October 13, 1992 to support the Examiner's Official Notice.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-16, 18-20 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majeti et al. (U.S. Patent No. 5,512,935) in view of Rothblatt (U.S. Patent No. 6,105,060).

Referring to claim 1, Majeti discloses receiving, by a server system (**see server 18 in Figure 1**), a request to receive an upgraded media feature for a programming transmission from a client system via a first communication media (**see Figure 1 and**

Column 3, Lines 29-42 for a client system requesting content from “enhanced service providers” over a PSTN communications network 24).

Majeti also discloses automatically coordinating retrieval, by the server system, of the upgraded media feature for the programming transmission with one of the plurality of programming transmission sources via a second communication media (see **Figure 1 and Column 3, Lines 42-55 for routing the request over telecommunications network 14 and receiving the requested enhanced content from the information/enhanced service providers 10A-10N via the telecommunications network 14**), the first communication media different than the second communication media (see **Figure 1 for the PSTN network 24 being different from the telecommunications network 14**).

Majeti also discloses automatically coordinating provision, by the server system, of the upgraded media feature for the programming transmission, the programming and the upgraded media feature to be provided from the one programming transmission source to the client system via a third communication media (see **Figure 1 and Column 3, Line 55 through Column 4, Line 2 for server/bridging unit 18 transmitting the requested enhanced content over distribution head-ends 30A-30N along with broadcasted television programming**), the third communication media different than the first and second communication media (see **Figure 1 for the cable distribution headends being a different communications media different from the PSTN network 24 and telecommunications network 14**).

Majeti fails to teach that the upgraded media features are purchased by the client.

Rothblatt discloses a backhaul system similar to Majeti that receives requests from a client device for supplemental data, wherein the supplemental data is distributed over a high speed communication network to the client device (**see Figure 1 and Column 16, Lines 33-46**). Rothblatt further discloses that the client device can purchase and be billed for the Internet usage (**see Column 16, Lines 46-48**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify server, as taught by Majeti, to include the accounting functionality, as taught by Rothblatt, for the purpose of providing a low-cost user terminal that allows user to receive satellite-based direct radio broadcast data (e.g. large geographic coverage, good sound quality, high outbound data rates and low cost), as well as bi-directional communication for global, portable Internet/WWW access capability (**see Column 1, Lines 61-67 of Rothblatt**) and also allow the system of Majeti to generate revenue for the requested supplemental data.

Referring to claim 2, Majeti also discloses receiving the selection from an entertainment system (**see Figure 1 for receiving the request from client system 20**), and the programming transmission is provided to the entertainment system with the upgraded feature via the third communication media (**see again Figure 1 and Column 3, Line 55 through Column 4, Line 2 for receiving the requested enhanced content and television programming from the cable distribution networks 10A-10N**).

Referring to claim 3, Rothblatt discloses billing, by the server system, the client system for services performed by the server system (**see the rejection of claim 1**).

Majeti and Rothblatt fail to disclose providing the billing information associated with the client system to the programming transmission source that provided the programming transmission.

The examiner takes Official Notice to the fact that programming transmission sources are well known in the art to receive additional data or services that have been ordered by a client system.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the programming transmission source, as taught by Majeti and Rothblatt, to include means for collecting data on what services the client system has ordered, for the purpose of allowing a programming transmission source to customize commercials or television programs to further target the preferences of a viewer.

Referring to claim 4, Rothblatt discloses that the billing is performed according to a billing cycle for transactions during the billing cycle (**see Column 16, Lines 46-48 for billing a customer according to a monthly billing cycle**).

Referring to claim 5, see the rejection of claims 1 and 4.

Referring to claim 6, see the rejection of claim 4.

Referring to claim 8, see the rejection of claim 1.

Referring to claim 9, see the rejection of claims 1 and 4.

Referring to claim 10, see the rejection of claims 1 and 4.

Referring to claim 11, Majeti discloses that the programming transmission is an audio production (**see the rejection of claim 1 and further note that a television production inherently contains an accompanying audio production**).

Referring to claim 12, Majeti discloses that the upgraded media feature is a video upgrade (**see Column 12, Line 58 through Column 13, Line 28**).

Referring to claim 13, Majeti discloses that a transmission source is a cable television source (**see Figure 1 for transmitting enhanced content and television programming through a cable headend 10A**).

Referring to claim 14, see the rejection of claim 1.

Referring to claim 15, see the rejection of claim 3.

Referring to claim 16, see the rejection of claim 5.

Referring to claim 18, see the rejection of claim 1.

Referring to claims 19-20, see the rejection of claims 9-10, respectively.

Referring to claims 25-26, see the rejection of claim 1.

(10) Response to Argument

Insufficient Factual Basis to Support Findings of Obviousness

Applicant argues that Majeti fails to teach or fairly suggest **"receiving, by a server system, a selection to buy an upgraded media feature for a programming transmission"**. The Examiner respectfully disagrees.

Majeti discloses transmitting upgraded media features in the form of supplemental data transmitted from enhanced service providers 10A-10N in Figure 1, wherein the supplemental data/upgraded media feature is transmitted along with additional television programming (**see Column 9, Lines 40-46 for transmitting requested information in the form of an upgraded media feature for a programming transmission**). The Examiner notes that by stating that the upgraded media feature is **"for"** a programming transmission (**which is an intention of use**), the claim does not specify in what way the upgraded media feature effects the programming transmission. Therefore, by transmitting the upgraded media feature/supplemental data with the television programming transmitted to the client device in Figure 1, Majeti teaches that the upgraded media feature/supplemental programming is **"for"** a programming transmission.

Applicant also notes that by reciting **"a selection"**, an indication that an upgraded media feature was selected from one or more alternative upgrades. The Examiner

respectfully disagrees and notes that a selection for a upgraded media feature given its broadest reasonable interpretation requires no such indication. For example a user could be provided with a single upgrade option or a plurality of upgrade options. Furthermore the claims provide no such guidance as to what is presented to a user upon selection of an upgraded media feature, therefore this argument is moot.

Applicant also argues that even if we were to assume that the information requested in Majeti could be construed as an upgraded media feature, which Appellant disputes (**see the Examiner's rebuttal above**), the information is still not "for the programming transmission" as clearly recited in the claims. Applicant further notes that in Majeti, the information solicited from the "enhanced service provider" is for the programming transmission because Majeti explicitly teaches that the information is split off from the cable programming and provided to a separate user device. The Examiner respectfully disagrees.

Again note that Majeti discloses supplementing transmitted television programming with additional data such as travel information, stock quotes and pictures, which are interpreted as upgraded features and therefore since the additional information is transmitted with the television programming and can be viewed in addition to the received television programming (**see Column 9, Lines 40-46**), Majeti clearly teaches that the upgraded media features are for a programming transmission (**note the Examiner's rebuttal above**). Further note that Column 12, Line 7 through Column 13, Line 17 for displaying the upgraded feature on the same display as the

programming (**television**) transmission (**also note combiner 174 in Figure 5**).

Applicant also argues that Majeti fails to teach “automatically coordinating purchase, by the server system, of the upgraded media feature for the programming transmission with one of a plurality of transmission sources”. Applicant further notes that the request is merely routed to an already identified service provider. The Examiner respectfully disagrees.

The Examiner notes that the claim recites “**with one of a plurality of programming transmission sources**”. Majeti clearly teaches that one of a plurality of programming transmission sources (**modems 54A-54N, enhanced service providers 10A-10N or cable distribution headends 30A-30N in Figure 1**) coordinates the retrieval of an upgraded media feature (**specifically from the enhanced service providers 10A-10N in Figure 1**) at channel service unit 38/control processor 48/router 42 in Figure 1 (**note Column 9, Lines 13-67**). The Examiner notes that the claims fail to state that the “one of the plurality of programming transmission sources” is specifically a television programming source of a plurality of television programming sources, therefore interpreting “one of the plurality of programming sources” as the enhanced service providers 10A-10N is a proper broadest reasonable interpretation.

As stated in the previous Office Action, Rothblatt is used to teach a similar type of transmission network that accesses Internet data/upgraded media features and coordinates such data/features for actual purchase (**see previous Office Action**).

Applicant also argues that Majeti also fails to teach "automatically coordinating provision, by the server system, of the upgraded media feature for the programming transmission, the programming transmission and upgraded media feature to be provided from the one programming transmission source to the client system via a third communication media, the third communication media different than the first and second communication media". The Examiner respectfully disagrees.

As previously recited in the claim, the purchase is coordinated with **"one of a plurality of programming transmission sources"**, where the Examiner has interpreted that **"one of a plurality of programming transmission sources"** can be modems 54A-54N, enhanced service providers 10A-10N or cable distribution headends 30A-30N in Figure 1. Therefore, **"the one programming transmission source to the client system via a third communication media"** can be any of the modems 54A-54N, enhanced service providers 10A-10N or cable distribution headends 30A-30N in Figure 1. In regards to this portion of the claim, the Examiner has chosen **"the one programming transmission source"** to be the cable distribution headends 30A-30N, which Majeti teaches transmits both the upgraded media feature/supplemental data with the television programming (**see again Column 9, Lines 40-46**).

In regards to the Official Notice taken in regards to dependent claim 3, Majeti and Rothblatt disclose all of the claim limitations in claim 1, as well as Rothblatt teaching billing, by the server system, the client system for services performed by the server system (**see Column 16, Lines 33-48**), but fails to teach providing billing information

associated with the client system to at least the one programming transmission source that provided the programming transmission.

Beyers discloses providing billing information (**from a set-top terminal**) associated with the client system to at least the one programming transmission source that provided the programming transmission (**see Figure 3 and Column 11, Lines 9-17 for providing billing information from the set top terminal to the system manager that provides programming transmissions (see Column 10, Line 52 through Column 11, Line 8)**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the billing system, as taught by Majeti and Rothblatt, using the billing system/process, as taught by Beyers, for the purpose of providing an RF data return path apparatus having a high data throughput to the degree of supporting a full range of services including IPPV services (**see Column 5, Lines 13-15 of Beyers**).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jason Salce

/Jason P Salce/

Primary Examiner, Art Unit 2421

November 20, 2009

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